UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,252	03/01/2000	Patrick G Sobalvarro	3654-2	3759

826   7590   06/18/2004

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

EXAMINER
GARG, YOGESH C

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.		Applicant(s)	
	09/516,252		SOBALVARRO ET AL.	
Office Action Summary	Examiner		Art Unit	
	Yogesh C Garg		3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>09 April 2004</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-37 and 39-92</u> is/are pending in the application.

    4a) Of the above claim(s) <u>1-37, 39-71 and 73-92</u> is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some *   c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/9/2004

has been entered.

Response to Amendment

2.   Amendment D, paper # 19, received on 4/9/2004 is acknowledged and entered.

Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 25,

26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 39, 40, 41, 42, 43, 44, 45, 46, 47, 48, 49,

50, 51, 52, 53, 54, 55, 56, 57, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72,

73, 74 are amended. New claims 75-92 have been added. Claim 38 is canceled.

Currently claims 1-37 and 39-92 are pending for examination.

Election/Restrictions

3.   Newly submitted claims 75-92 and newly amended claims 1-37, 39- 71 and 73-

74 are directed to an invention that is independent or distinct from the invention originally

claimed for the following reasons: The inventions of newly submitted claims 75-92 and

newly amended claims 1-37, 39- 71 and 73-74 are directed to receiving a request for

package from a consumer and then   dynamically generating a package from one of

plurality pre-stored templates. The earlier invention of claims as presented in amendment c, paper # 16, were directed to offering items for sale in a group (see the applicant's remarks in amendment c, paper # 16, on page 17, lines 24-25), creating a package template and generating a package based on one customer constraint, one package template and one stored component description. The earlier invention of claims as presented in amendment C, paper # 16, were not directed to (a) receiving a request for a package from a consumer, (b) creating a plurality of package templates and storing them (c) generating a package from one of plurality pre-stored templates based upon the request for a package from a consumer.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-37, 39- 71 and 73-74 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The amended claim 72 in the present amendment D is directed to the originally presented invention and it is considered on further merits. This claim is a product claim directed to a data structure. The limitations , " at least one field stating........defining matching criteria" which constitute the main body of the claim are not changed hence this claim is still considered as part of the originally presented invention. The "wherein the package.....via a web interface" clause does not further limit the structural elements of the claim but merely shows the capability or intended use of the recited data structure and adds nothing to the patentability or substance of the claim. A "whereby" or "wherein" clause is a type of functional language that appears in claims. "Functional" indicates nothing more than the fact that an attempt is being made to define something by what it does rather than by what it is. There is nothing intrinsically wrong with the use of such a

technique in drafting patent claims. See In re Swinehart, 169 USPQ 226 (CCPA 1971).

However, "Whereby" clauses can take different forms. They can describe the result

which follows from the steps or structure recited, or they can clarify or further limit a

previously recited feature. In this case the "whereby" clause merely states the result of

the limitations/intended use in the claim adds nothing to the patentability or substance of

the claim, which consists of structural elements. See Texas Instruments Inc. v.

International Trade Commission, 26 USPQ2d 1018 (CAFC 1993).

In view of above claim 72 is further treated on merits.

Response to Arguments

4   Applicant's arguments (see pages 21-24 of the amendment D) are directed to the

withdrawn claims 1-37, 39-71, and 73-92 constituting an invention that is independent or

distinct from the invention originally claimed for the reasons provided above hence are

moot. Since the claim 72 does not provide any new limitations as analyzed above it is

rejected based on the same rationale as submitted in the previous office action pages 9-

10.

This is a non-final rejection.

Claim Rejections - 35 USC § 101

5   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition
> of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claim 72 is rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Claim 72 is directed to disembodied data

structure which are per se not statutory. C.f. In re Wamerdam. Independent claim 72

claims " at least one field", " a list of required attributes", and " at least one coordinate

defining matching criteria" and these all represent a data structure resembling a data file

without reciting any functional changes due to an application program and resulting in an

useful, concrete and tangible result. Functional descriptive material, in combination with

a computer readable medium must be capable of producing a useful, concrete and

tangible result when used in a computer system is statutory i.e., a set of instructions in

combination with a computer system. C.f. *In re Wamerdam* - data structure stored in a

computer memory, and *In re Lowery, 32 USPQ2d 1031 (Fed. Cir. 1994)* - data structure

in a computer readable medium.

A claim to a computer readable medium encoded with functional descriptive

material that can function with a computer to effect a practical application that results in

a useful, concrete an tangible result (i.e. running an assembly line or executing a stock

transaction) satisfies Section 101. Examples of Statutory Functional Descriptive Material

are:

(a) A claimed computer-readable medium encoded with a functional data

structure – this defines structural and functional relationships between the data structure

and the hardware/software components. See *Wamerdam*.

(b) A claimed computer-readable medium encoded with a computer program -

this defines structural and functional relationships between the computer program and

the computer itself which allows the program's functionality to be realized provided that a

useful, concrete and tangible result is realized. See U.S. Patent 5,710,578 to

Beauregard et al.

6.   Examiner cites particular columns and line numbers in the references as applied

to the claims below for the convenience of the applicant. Although the specified citations

are representative of the teachings in the art and are applied to the specific limitations

within the individual claim, other passages and figures may apply as well. It is

respectfully requested that, in preparing responses, the applicant fully consider the

references in entirety as potentially teaching all or part of the claimed invention, as well

as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 72 is rejected under 35 U.S.C. 102(e) as being anticipated by Jones.

Regarding claim 72, Jones discloses a package schema data structure

comprising:

at least one field stating whether an element is mandatory or optional;

a list of required attributes;

at least one coordinate defining matching criteria;

(see for the above limitations at least , page 2, paragraph 0030, 0031, 0034,

page 3, paragraph 0040. Note: "activity and restaurant information " in Jones relate to

one optional element in the application and the "details about air travel, destination and

required time to be at destination" correspond to the mandatory element. The information shown in FIG.2B shows a list of required attributes for the air travel. FIG.5B and FIG.6B show at least one coordinate defining matching criteria such car size and type or required cuisine and ambiance for a restaurant selection respectively).

The "wherein the package.....via a web interface" clause does not further limit the structural elements of the claim but merely shows the capability or intended use of the recited data structure and adds nothing to the patentability or substance of the claim. A "whereby" or "wherein" clause is a type of functional language that appears in claims. "Functional" indicates nothing more than the fact that an attempt is being made to define something by what it does rather than by what it is. There is nothing intrinsically wrong with the use of such a technique in drafting patent claims. See In re Swinehart, 169 USPQ 226 (CCPA 1971). However, "Whereby" clauses can take different forms. They can describe the result which follows from the steps or structure recited, or they can clarify or further limit a previously recited feature. In this case the "whereby" clause merely states the result of the limitations/intended use in the claim adds nothing to the patentability or substance of the claim, which consists of structural elements. See Texas Instruments Inc. v. International Trade Commission, 26 USPQ2d 1018 (CAFC 1993).

However, Jones does suggest that the package schema data structure is used along with a plurality of other package schema to dynamically develop, in response to a consumer request for a package, at least one package of a plurality of elements to be offered for sale over the Internet via web interface (see at least a package schema for airline tickets [see FIG.8A-8D], a package schema for Hotels [FIG.4A-4B], a package schema Rental cars [FIG.5A-5C], and a package schema for Restaurants [FIG.6A-6B]) . These package schemas are used by a matching engine to match requirements (see at least paragraph, 0030, "......A user need only input a goal, including a destination.....the

travel system presents the user with alternatives that allow the user to meet these criteria. Other convenient information is presented to the user that is specifically tailored to the users' travel plans, including hotels, restaurants....". Note: The received and entered users' travel plans and inputs correspond to the data structure of the templates generated and these templates include attributes and affinity space information in the form of users' preferences as suggested in FIGs. 4-8.).

Conclusion

8   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,434,450 B1 to Griffin, Jr. et al. (see at least col.4, lines 31-39.) and US Publication no: 20010000047 A1 to Madany et al. (see at least page 3, paragraph 0046) disclose receiving a request and based on that request generating/assembling a package for transmission to the requestor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
June 10, 2004